THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETROLITE CORPORATION

Appeal No. 97-0669
Control No. 90/002,726[1]

ON BRIEF

Before KIMLIN, GARRIS and WARREN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-3, 6, 8 and 22 in the reexamination proceeding of U.S. Patent No. 4,818,410. Claims 4, 5, 9-15, 17 and 19-21 have either been allowed by the examiner or objected to as being dependent upon

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[1] Request filed May 15, 1992, Control No. 90/002,726, for the Reexamination of U.S. Patent No. 4,818,410, issued April 4, 1989, based on Application 07/143,438, filed January 14, 1988.

a rejected claim. Claims 7, 16 and 18 have been canceled.

Claim 1 is illustrative:

1. A method of removing water soluble organics from an oil well production fluid, which comprises crude oil and water, comprising the steps of:

(a) adding to the oil well production fluid a strong acid to adjust the pH of the fluid to within the range of about 2-6;

(b) thereafter or simultaneously making intimate contact between the water and oil phases with the result that the content of water soluble organics in the water is substantially reduced by being transferred from the water phase to the oil phase; and

(c) separating the oil phase and the water phase.

In the rejection of the appealed claims, the examiner relies upon the following reference:

Ruebush et al. (Ruebush)	4,839,054	June 13, 1989

The claimed method on appeal, which is directed to removing water soluble organics from an oil well production fluid, comprises (a) adding a strong acid to the production fluid to adjust the pH to within the range of about 2-6, (b) making intimate contact between the water and oil phases in order to transfer the water soluble organics from the water phase to the oil phase, and (c) separating the oil and water phases.

Appellant submits at page 5 of the principal Brief that all the appealed claims stand or fall together. Accordingly, we will limit our discussion to the examiner's rejection of claim 1.

Appealed claims 1-3, 6, 8 and 22 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Ruebush.

Upon thorough review of the opposing arguments presented on appeal, we concur with appellant that the prior art patent to Ruebush does not describe the claimed subject matter within the meaning of 35 U.S.C. § 102. Accordingly, we will not sustain the examiner's rejection.

Both appellant and the examiner agree that the sole issue on appeal is whether the claimed "oil well production fluid" is equivalent to the "oil field produced water" described by Ruebush (see page 6 of appellant's principal Brief, last paragraph, and page 4 of Examiner's Answer, first sentence). It is appellant's contention that the "oil field produced water" of Ruebush is water which has been sequestered, or removed, from oil well production fluid. Appellant relies upon separate declarations of G. H. Holliday and Dan D. Caudle as well-recognized experts in the field to establish that "the

term 'oil field produced water' in Ruebush refers to a water stream which is DERIVED from a production oil well fluid" (page 7 of principal Brief). Appellant maintains that the claimed "oil well production fluid" is that fluid that is drawn directly from the ground which, therefore, contains substantially more oil than the "oil field produced water" of Ruebush. In the words of appellant, "the claims of Appellants reference the addition of acid directly to an oil well production fluid, i.e., a fluid containing both crude oil and water. In the claims of Ruebush, on the other hand, acid is added to a stream which has been sequestered from crude oil" (paragraph bridging pages 13 and 14 of principal Brief).

It is the examiner's position that since appealed claim 1 defines "oil well production fluid" as comprising crude oil and water, the subject matter of claim 1 is anticipated by Ruebush's disclosure that "oil field produced water" comprises water and naturally-occurring petroleum, which includes crude oil. According to the examiner, "[a]ll of the admissions, case law citations, literature references, and declarations cited by appellants are insufficient to overcome this teaching of Ruebush et al." (page 4 of Answer).

In our view, the objective evidence of record clearly establishes a meaningful distinction between the claimed "oil well production fluid" and the "oil field produced water" of Ruebush. Appellant's patent specification, at column 2, lines 45 et seq., describes aqueous streams to be treated as oil well production fluids from which oil has been primarily separated comprising petroleum organic substances. Also, EXAMPLE 1 describes production oil well fluid as that obtained from a California oil field comprising about 90% water and 10% crude oil. In addition, the Holliday and Caudle declarations provide substantial evidence that one of ordinary skill in the relevant art understands that the language "oil well production fluid" refers to fluid obtained from geological formations during the production of wells.

On the other hand, the disclosure of Ruebush and the declarations of Holliday and Caudle provide persuasive evidence that the "oil field produced water" of Ruebush pertains to a stream of water that has been separated from the oil components of a production oil well fluid. From the Ruebush disclosure at column 1, lines 16 et seq., it is quite clear that the oil field produced water refers to aqueous

streams that are generated by industrial processes, such as offshore oil platform operations.

Consequently, based upon the teachings of Ruebush and appellant's specification, as well as the Holliday and Caudle declarations, we are satisfied that, although appellant's "oil well production fluid" and Ruebush's "oil field produced water" both comprise water and oil, the compositions are not the same, and, therefore, one of ordinary skill in the art would not find a description in Ruebush of the presently claimed method of removing water soluble organics from an oil well production fluid. In the absence of such a description in the Ruebush reference, we cannot sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 102.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
BRADLEY R. GARRIS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES

)
)
CHARLES F. WARREN)
Administrative Patent Judge)

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